



23 JUN 2006

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON DC 20037

In re Application of

May

Application No.: 10/529,326

PCT No.: PCT/EP03/10634

Int. Filing Date: 24 September 2003

Priority Date: 25 September 2002

Attorney Docket No.: 119508-00282

For: Torque Signal Transmission

DECISION

ON

PETITION

This is in response to the petition under 37 CFR 1.47(b) filed on 28 October 2005.

BACKGROUND

This international application was filed on 24 September 2003, claimed an earlier priority date of 25 September 2002, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 08 April 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 25 March 2005. Applicants filed *inter alia* the basic national fee on 25 March 2005.

On 31 August 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(h).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known addresses of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding requirement (1), petitioner paid \$130.00 toward the petition fee on 28 October 2005. The remaining \$70.00 is being charged to counsel's Deposit Account No. 23-2185, as authorized by the instant petition.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of sole inventor Lutz Axel MAY be excused because he allegedly has refused to execute an oath or declaration. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor

is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Counsel has not adequately substantiated his assertion that Mr. May has refused to sign the declaration under the standard enunciated above. The evidence of record suggests that a complete copy of the application papers may not have been provided to Mr. May, along with the oath or declaration document, prior to his alleged refusal to execute the oath or declaration. Paragraph 14 of the Declaration of Dr. Alexander Straus states in part that "Lutz May's attorney contends that not all of the file wrapper papers were provided. While this is in fact true, we did provide him with the relevant application papers, as noted above and shown in Appendix V." Petitioner has not shown exactly what "relevant application papers" were provided to Mr. May. Appendix V as provided has not been translated from German (as is true of many of the other documents accompanying the instant petition), and the record includes no statement made on the basis of first-hand knowledge to the effect that a complete copy of the application was presented to Mr. May along with an oath or declaration for his signature.

Counsel cites paragraphs 6, 7 and 13 of the Declaration of Alexander Straus to support the premise that Mr. May refused to execute the oath or declaration. Paragraph 6

states that Mr. May was contacted on 19 February 2004 "to obtain his signature on documents to be signed," and that "he refused to do so." This paragraph does not specifically identify an oath or declaration of inventorship directed to this application as among the "documents to be signed," nor does it set forth any of the details of the alleged refusal (such as specific statements Mr. May may have made). Moreover, it is not clear whether these statements are made on the basis of first-hand knowledge. In paragraph 7, counsel refers to actions allegedly undertaken by Dr. Gleichenstein (a German bankruptcy receiver or trustee) "to acquire Lutz May's signatures," and refers to (untranslated) Annex II. Again, this evidence is insufficient because it is not clear that Mr. May specifically refused to execute an oath or declaration directed to this application, and moreover the statements available in English are not made on the basis of first-hand knowledge. Meanwhile, paragraph 13 does specifically refer to a declaration, a specification, claims, drawings, "and any amendments thereto" as having been sent to Mr. May via his attorney. Again, these statements do not specify that the papers transmitted pertain to this specific application, and they have not clearly been made on the basis of first-hand knowledge. Also, these statements are allegedly supported by further untranslated German language documentation. Moreover, as noted above, there is a question (raised by paragraph 14) as to whether the copy of the application provided to Mr. May was complete. Thus, the evidence of record does not adequately establish that Mr. May has refused to execute the oath or declaration within the meaning of 37 CFR 1.47(b).

Regarding requirement (3), the petition includes a statement the last known address of Mr. May. Accordingly, requirement (3) has been satisfied.

Concerning requirement (4), the instant renewed petition is accompanied by a declaration naming "Lutz Axel May, a citizen of Germany" as the inventor and executed "By: Stephen U. Harders Its: Assistant Secretary," who asserts that "I am an individual empowered to act on behalf of Abas, Inc." This declaration is acceptable for purposes of compliance with requirement (4).

Regarding requirement (5), petitioner's attention is respectfully directed to 37 CFR 3.73(b)(1), which provides that

In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

- (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or
- (ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

and to MPEP 409.03(f), which provides in part that

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). An assignment to a 37 CFR 1.47(b) applicant for the sole purpose of obtaining a filing date for a 37 CFR 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and 37 CFR 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter. A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner argues that Mr. May was an employee of bankrupt firm FAST Technology AG and argues circumstantially that FAST should be considered to have been "the owner of the above-captioned patent application and the invention disclosed therein," and cites paragraph 11 of the Straus declaration as support. However, paragraph 11 of Straus appears to be merely an assertion of "Abas, Inc.'s position," possibly based on hearsay, and not an objective evidentiary showing. Petitioner has included a copy of a transfer agreement from Dr. von Gleichenstein

(trustee/receiver) to Magna-lastic Devices, Inc. of rights in certain patent applications, but the instant application does not appear to be named in said document, either by U.S. or international application number. Moreover, petitioner has not provided sufficient proof that any rights in this application were conveyed from Magna-lastic to Abas; instead, petitioner merely refers to an assertion by Steven Harders that the application was "subsequently assigned" to Abas. In the absence of a sufficient showing of the alleged proprietary interest of Abas, Inc. in this application, it would be inappropriate to conclude that requirement (5) has been satisfied.

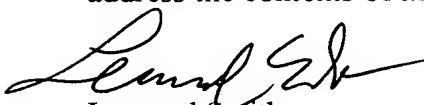
Regarding requirement (6), the petition includes an assertion that the requested action is necessary to preserve the rights of Abas, Inc.

DECISION

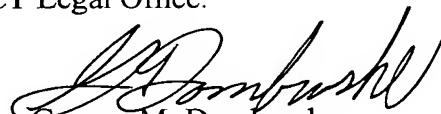
The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration



George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459